REMARKS

Entry of this Amendment is proper under 37 C.F.R. § 1.116 because the Amendment places the application in condition for allowance for the reasons discussed herein; and does not raise any new issues requiring further search and/or consideration as the amendments amplify issues previously discussed throughout prosecution. Entry of the Amendment is thus respectfully requested.

Claims 1-22 are indicated in the Office Action as pending, without mention of claims 23-24. Applicants note that claims 23-24 were added by way of the Reply and Amendment of November 1, 2002. However, in light of the amendments made herein to claim 1, claims 23-24 are canceled herein as redundant.

Claims 1, 2, 3 and 19 have been amended by way of the present Amendment, and new claim 25 is added. Claim 1 has been amended to recite a pore-forming agent that is soluble in body fluids, that has a mean particle size of 0.5-100 μm and which is 40-95% by weight of the total weight of the dry coating. Basis for these amendments may be found throughout the specification and claims as-filed (especially claims 2, 3 and 19), and especially at page 4, lines 7-10, 11-13, 17-20 and page 5, line 34 to page 6, line 2. Claims 2, 3 and 19 have been amended so to not be redundant in light of the amendments to claim 1. Claim 19 has also been amended to remove reference to alternative subject matter, which has been made the subject of new claim 25.

Thus, no prohibited new matter has been added by way of this Amendment. Applicants reserve the right to file a continuation or divisional application directed to any subject matter canceled by way of this Amendment.

Rejections under 35 U.S.C. §102

Claims 1, 2, 4, 7- 9, 11-16, 20 and 21 stand rejected under 35 U.S.C. § 102(b) as purportedly being anticipated by U.S. patent 5,639,476 to Oshlack *et al.*

Oshlack *et al.* is cited for purportedly disclosing a controlled release dosage form, comprising a substrate containing an active agent, said substrate being coated with a plasticized aqueous dispersion consisting essentially of copolymers which are copolymers of acrylic acid and methacrylic acid esters, and a further material which can be a pore-former. Applicants respectfully traverse.

For proving anticipation, "anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention as arranged in the claims." Jamesbury Corp. v. Litton Industrial Products, Inc. 225 U.S.P.Q. 253, 256 (Fed. Cir. 1985). The cited reference does not describe or suggest all of the elements of the rejected claims, as discussed in greater detail below.

Before turning to the cited reference, Applicants provide the following comments regarding the claimed invention. The claims of the present application relate to methods of producing controlled release pharmaceutical preparations by preparing a drug containing a solid core, suspending a pore-forming agent having a balanced solubility in an aqueous dispersion, coating the solid core with the suspension, and drying the coated tablet. The claims also relate to controlled release preparations comprising a solid core and a pore-forming agent having a balanced solubility in an aqueous dispersion.

"Balanced solubility" describes one important feature of the pore-formers used in the methods and preparations of the instant invention. In support of this assertion,

Applicants submit herewith a Declaration pursuant to 37 C.F.R. § 1.132 by a named inventor and expert in the field: Dr. John Kendrup. As is evident from Dr. Kendrups's Declaration, balanced solubility is an important and novel aspect to the present invention. To this regard, Applicants refer the Examiner especially to paragraphs 9-13 of Dr. Kendrup's Declaration.

Further, claim 1 has been amended herein to recite a pore-forming agent that is soluble in body fluids, that has a mean particle size of 0.5-100 μm and which is 40-95% by weight of the total weight of the dry coating.

Regarding the cited reference, Applicants submit that Oshlack *et al.* fail to recite pore formers with balanced solubility, let alone all of the elements of the presently claimed invention as amended herein. Applicants again refer the Examiner to Dr. Kendrup's Declaration, which provides a detailed discussion of how the cited reference fails to recite the elements of the present invention. Thus, in light of the above remarks, amendments to the claims and the Declaration pursuant to 37 C.F.R. § 1.132 submitted herewith, Applicants request that this rejection be withdrawn.

Rejections under 35 U.S.C. §103

Claims 1-22 stand rejected under 35 U.S.C. §103(a) as purportedly being unpatentable over Oshlack *et al.* The Office Action asserts that Oshlack *et al.* disclose the claimed process although they do not specifically teach the claimed particle size for the pore formers, and that the skilled artisan would have been motivated to use any pore former in the process taught by Oshlack *et al.* Applicants traverse.

In order to establish a case of *prima facie* obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation to modify the reference or combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art reference(s) must teach or suggest all of the claim limitations. *See* M.P.E.P. §2142. Applicants respectfully submit that these criteria have not been met in the present Office Action.

As noted above, claim 1 has been amended to recite a pore-forming agent that is soluble in body fluids, that has a mean particle size of 0.5-100 μm and which is 40-95% by weight of the total weight of the dry coating. Applicants further note that the present invention provides a method which is water based, and does not involve organic solvent, in order to achieve a controlled release dosage form with good strength. As disclosed in the present specification, the type (particularly the solubility), the amount and the particle size of the pore-forming agent are important in addition to the "balanced solubility".

To this end, Applicants again refer the Examiner to the Declaration pursuant to 37 C.F.R. § 1.132 by Dr. John Kendrup. This Declaration provides data showing the benefits of pore-formers having balanced solubility, and that the coatings prepared using the pore-formers of the present invention possess the desired properties of (1) good coating strength, (2) appropriate release of the active ingredient at a rate acceptable for active ingredient delivery to the patient, and (3) substantially decreased risk of rupture of the formulation due to pressure. None of these attributes are discussed in the Oshlack *et al.* reference, nor are methods taught or suggested for overcoming these defects with regard to any pore-former, let alone with relation to the use of the pore-formers of the instant invention.

Specifically, nothing in the Oshlack patent '476 discloses or suggests the advantages of using a pore-forming agent having a "balanced solubility" and the problems which can be solved by using such a pore-forming agent. Furthermore, nothing in the Oshlack reference is disclosed regarding the particle size of the pore-forming agent, wherein an innumerable amount of pore-formers are listed. The pore-formers have water solubilities which can vary from very soluble to insoluble.

As discussed in the attached Declaration, an agent is disclosed, lithium carbonate, which may be potentially useful in the method according to the present invention. However, lithium toxicity is closely related to serum lithium levels, an can occur at doses close to therapeutic levels. Lithium toxicity is so much of a concern that it is recommended that facilities for prompt and accurate serum lithium determinations be available before initiating therapy with lithium carbonate. The use of lithium carbonate as pore-forming agent in a pharmaceutical preparation would certainly not be contemplated by the skilled artisan.

Thus, Oshlack *et al.* fail to recite all the elements of the present invention and fail to motivate the skilled artisan to alter the invention of provide an expectation of success. Thus, in light of the above remarks, amendments made herein and the Declaration pursuant to 37 C.F.R. § 1.132 submitted herewith, Applicants request that this rejection be withdrawn.

CONCLUSION

Based on the foregoing, this application is believed to be in condition for allowance. A Notice to that effect is respectfully solicited. However, if any issues remain outstanding after consideration of this Amendment and Reply, the Examiner is respectfully requested to contact the undersigned so that prosecution may be expedited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: July 28, 2003

By: _____
Deborah H. Yellin
Registration No. 45,904

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620